

REMARKS

I. THE STATUS OF THE CLAIMS

Claims 1, 2 and 10-12 are under examination. Claim 13 is added. Support for claim 13 can be found in the specification at page 5, line 14.

II. THE INFORMATION DISCLOSURE STATEMENT

Applicants submit herein an Information Disclosure Statement.

III. THE REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects claims 1, 2 and 10-12 under 35 U.S.C. § 102 as being anticipated by Guillemont, WO03016306. Applicants respectfully traverse the rejection.

WO03016306, which was filed in the PCT August 9, 2002, claims priority to two applications, namely EP01203090.4, filed August 13, 2001, and EP02077748.8, filed June 10, 2002. The present application, which was filed in the U.S. on February 8, 2005, is a National Stage Entry of PCT/EP03/50366, filed August 7, 2003, which in turn claims priority to EP2078306.4, filed August 9, 2002.

MPEP 2136.03, which is entitled "Reference's Foreign Priority Date Under 35 U.S.C. 119(a)-(d) and (f) Cannot Be Used as the 35 U.S.C. 102(e) Reference Date" states that a foreign priority filing date cannot be used as a 102(e) reference date for prior art purposes.¹ In

¹ An excerpt from MPEP 2136.03 is reproduced below (emphasis added):

35 U.S.C. 102(e) is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant" (emphasis added). Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a) - (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority

contrast, MPEP 2136.03 also states that an applicant can use its foreign priority filing date to overcome a 35 U.S.C. 102(e) rejection. Therefore, the 2001 and 2002 European foreign priority filing dates for WO03016306 cannot be used for 102(e) purposes and, rather, the August 9, 2002 International filing date must be used. The above-identified patent application was filed in Europe on the same day, i.e., August 9, 2002. For this reason, WO03016306 cannot be prior art to this application. Reconsideration and withdrawal of the rejection of claims 1, 2 and 10-12 under 35 U.S.C. § 102 as being anticipated by WO03016306 are respectfully requested.

dates under 35 U.S.C. 365(a). **Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date.** In re Hilmer, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (Hilmer I) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. The court held that the reference's Swiss priority date could not be relied on in a 35 U.S.C. 102(e) rejection. Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed.). See MPEP § 201.15 for information on procedures to be followed in considering applicant's right of priority.

Note that certain international application (PCT) filings are considered to be "filings in the United States" for purposes of applying an application publication as prior art. See MPEP § 706.02(a)...

IV. THE REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects claims 1, 2 and 10-12 under 35 U.S.C. § 103 as being obvious over Guillemont, WO03016306. Applicants respectfully traverse the rejection.

In response, Applicants respectfully submit that for the reasons stated in response to the rejection of claims 1, 2 and 10-12 under 35 U.S.C. § 102, WO03016306 cannot be prior art to this application. Reconsideration and withdrawal of the rejection of claims 1, 2 and 10-12 under 35 U.S.C. § 103 as being obvious over WO03016306 are respectfully requested.

V. THE DOUBLE PATENTING REJECTION

The Office Action rejects claims 11 and 12 under the judicially created doctrine of obviousness-type double patenting. In response, Applicants submit that the cancellation of claims 11 and 12 obviates any basis for the rejection of claims 11 and 12 under the judicially created doctrine of obviousness-type double patenting. Reconsideration and withdrawal of the rejection of claims 11 and 12 under the judicially created doctrine of obviousness-type double patenting are respectfully requested.

VI. CONCLUSION

Early consideration and prompt allowance of the claims are respectfully requested.

Respectfully submitted,

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Attachment:
Information Disclosure Statement